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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,688	07/27/2006	Steffen Tiede	3764	8412

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EXAMINER

REDDING, DAVID A

ART UNIT	PAPER NUMBER
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3723

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12/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,688	Applicant(s) TIEDE ET AL.	
	Examiner /David A. Redding/	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/27/06</u> . | 6) <input type="checkbox"/> Other: ____. |

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show clamping element 45 in figure 1 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “54” has been used to designate both filter and spring in figure 7 ;reference character “60” is used to identify different elements in figure 5.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: page 6, last line, after "20" delete - - a - -; page 7, line 4, delete second occurrence of "on".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 1,5,6,7,17,18,20, the phrase "in particular" or "particularly" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 1,10,21, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 5, the phrase "for instance" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 6 and 12, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 9 recites the limitation "reinforcing parts" in 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 12 and 13 recites the limitation "the two cases" in 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 12, line 2, delete "characterized in that".

Claim 15 recites the limitation "dust lid" in 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the lid" in 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 19 recites the limitation "the switch button" in 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1,2,11, are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,817,495 (Luck).

Luck discloses a portable rectangular-shaped carry case 10 with a closable lid 12 the underside which is shaped like a dish, an air compressor 19 within the case 10 for providing pressurized air to an air powered gun (tool) 28, the case 10 including a box 22 the sidewall thereof forms a vertical partition which forms one part of a compartment for tool 28 (see figure 6). The case 10 includes storage space for air hose line 29.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 9403264 (Revell).

See figures 1,3, and 4.

Claims 1,3,11,12,16,18 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1 321 247 (Valentini).

Valentini discloses a portable case 1 forming a housing which has closable lids 6,9,26, for compartments 5,40,14, respectively. Compartment 40 houses an electric aspirator, compartment 14 houses a dust bag, compartment 5 houses the tool 2, and compartment 17 houses the power cord for providing electric power to the aspirator which provides a vacuum to tool 2 collecting the dust generated into dust storage bag 15. Compartment 5 includes a vertical partition separating compartment 5 from compartments 14 and 40. Figures 7-10 illustrate the embodiment which reads on claims 12. Figure 1 shows a latch which reads on the claimed sealing means of claim 16 and hand-actuatable user control element of claim 18.

Claims 1-3,5,6,8,11,14,18,19 rejected under 35 U.S.C. 102(b) as being anticipated by US 2003/0208874 (Steffen et al.).

Steffen et al. disclose a portable tool storage case 20 having a housing 22 with a closable lid 26 hingedly connected via hinges 58. The housing 22 has a compartment 86 having a vacuum cleaner 70 which provides a suction force to inlet 106 which connects to vacuum hose 90 and vacuum tool 92 or 94 for drawing debris through tools 92,94 into hose 90 into the dust bin 150 and to exhaust outlet 120. The case 20 includes a handle 34 which in an upright position has retainer member 36,38 which form a mushroom cap-shape and provide a surface to wind a power cord 44. The upper flat surface of handle forms a parking face. The inner surface of the lid forms a compartment for tool 92,94 held in place by resilient elastic grips 98. Figure 8 shows structural ribs (not numbered reinforcing the exterior wall of the case, reading on claim 8. Figures 6 and 7 shows a u-shaped depression in the lid which includes walls (partitions) forming a compartment for tools 92,94. Case includes a switch 108 for powering the vacuum motor reading on claim 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7,10,21-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0208874 (Steffen et al.).

Regarding claim 7, Steffen et al. shows the suction inlet 106 and blower outlet 120 on different walls of the case as opposed to side by side, as claimed.

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) holds rearrangement of known parts without a change in function is obvious. Accordingly, it would have been obvious to one skilled in the art to rearrange the suction port and blower outlet in Steffen et al. side by side, without any change in function of the parts.

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The color scheme defined in claim 10 is considered to be an obvious design choice. In re Seid , 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

The use of hose extensions and hose couplers with vacuum hoses is known and would have been obvious to include with the cleaning and tool storage assembly in Steffen et al.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1321247 (Valentini) as applied to claim 1 and further in view of USP 6,101,667 (Ishikawa).

Ishikawa discloses a bypass valve for controlling the suction force in a vacuum cleaner. Accordingly, it would have been obvious to one skilled in the art to include the bypass valve of Ishikawa into the lid of the tool box of Valentini for controlling the suction force to the sanding tool.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1321247 (Valentini) as applied to claim 1 and further in view of USP 4,416,033 (Specht).

Specht discloses a full dust bag indicator for alerting the user to empty or replace the bag in a vacuum cleaner. Accordingly, it would have been obvious to one skilled in the art to include the full bag indicator of Specht into the lid of the dust box of Valentini in view of the known use in Specht.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1321247 (Valentini) as applied to claim 1 and further in view of USP 2005/0156564 (Krieger).

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Krieger discloses a tool box including a removable LED light source. Accordingly, it would have been obvious to one skilled in the art to include an LED light source in the container of Valentini in view of the known practice as taught in Krieger.

Allowable Subject Matter

Claims 4,9, and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /David A. Redding/ whose telephone number is 571-272-1276. The examiner can normally be reached on Mon.-Fri. 6:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David A Redding/
Primary Examiner
Art Unit 3723

DAR